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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-22 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-22 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

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1. The Examiner believes that the correct number of <sup>the</sup> U.S. patents set forth at page 2 line 27 of the specification is 4,917,926.

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

3. Claims 21 and 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, in claim 21 there is no recitation in the claim of what constitutes the particular orders of the first, second, and third layers.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any

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person skilled in the art to make and use the invention. More particularly, the disclosure at page 8, lines 6-24 of the specification which relates to "specific examples of materials classes" is not tied to the rest of the specification in such a way as to teach one of ordinary skill in the art just what embodiments and specific elements are being referred to. Also, at page 8, line 1 the word "abhesive" is believed to more properly be <sup>a b</sup>~~an~~herent layer.

6. Claims 8-13 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon a defective specification.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

8. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability

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shall not be negatived by the manner in which the invention was made.

10. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Spies et al. Note particularly Examples 1 and 2, together with the Abstract, column 1 lines 4-33, column 2 lines 1-19, lines 25-32~~4~~. It would appear from Example 1 at column 3 lines 50-51 that the limitation of claim 1 wherein a "self wound" water dissolvable tape is taught, <sup>is disclosed</sup> but if such an embodiment is not specifically cited in the Example it is believed to be clearly inherent from the aforementioned disclosure.

11. Claims 5-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spies et al. The reference is again relied upon substantially as set forth above, teaching a genus of adhesive tapes (sealing tapes) that feature both repulpable pressure sensitive adhesive compositions coated onto a suitable paper backing (taught by applicants' specification at page 7, line 7 as a suitable substrate material). On the opposing outer surface of the paper carrier or backing is coated a suitable silicone free, fully repulpable release layer. With respect to the dependent claims, the presence of a water insoluble, discontinuous phase in either the substrate, adhesive layer or "abherent layer" or all three such layers (claim 21) reads upon, e.g. the presence of a wide variety of well known filler materials. As to claims 8-13, these are each believed to read

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upon well known polar functional groups that can be incorporated into the substrate, and the remaining dependent claims 14-20 reading upon such well known elements as soluble starches, ionic salts of polyacrylic acid, and water insoluble, discontinuous phase of cellulose fibers, or a high molecular weight acrylic acid are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

12. Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. The reference discloses (the entire disclosure, particularly the Abstract, column 1 line 50 - column 2 line 47, and column 12 lines 35-64) ~~discloses~~ a suitable genus of pressure sensitive adhesive tapes whose adhesive composition can comprise microparticles and a water dispersible component, together with (column 12 lines 35-45) a broad genus of suitable backings which can include paper and/or other water soluble or dispersible backings together with a suitable release coated substrate if so desired. The reference does not expressly teach the presence of the adhesive tape being wound upon a roll nor is the genus of release coated substrates (column 12 lines 56-64) expressly taught as being water soluble or water dispersible; however, note, e.g. that the Abstract teaches "the tape may be repulpable". Additionally, applicants' independent claim does not require the presence of a release layer, and the utilization of repulpable release layers are <sup>also</sup> well

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known to one of ordinary skill in the art. With respect to the dependent claims, these are each believed to be obvious modifications to one of ordinary skill, as taught above, in the absence of unexpected results.

13. Claim 22 is not rejected on the basis of adverse prior art.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also applicants' PG publication U.S. 2002/0182403A1, and Nakamura et al.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc  
February 26, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zirker*